

As to the double patenting rejection concerning U.S. Patent No. 5,761,648, applicants agree to provide an appropriate terminal disclaimer upon notification of allowable subject matter.

As to the double patenting rejection concerning Application No. 09/484,290, without waiving the right to argue patentable differences, following the procedure recited in MPEP § 804, since the Examiner has both this application and the `290 application, she will know whether it is proper to maintain the rejection in light of status of these cases.

The § 112 Rejections

Claim 36: The Examiner states that the specification lacks written description for the feature of "the coupon offers being transferred to a location designated by an issuer system" (see Office Action, p.4). Applicants respectfully disagree noting, for example, FIGURE 1 and page 9 of the specification as originally filed, at lines 11-14, where it is explained that in a second method of redeeming a coupon, the consumer PC 2 "transmits the selected coupon file 5 to a data base 7 designated by the issuer ... The check-out system at the retail outlet outlet 8 would then automatically activate the discount if the consumer ... purchased the designated product."

Claim 37: The Examiner states that the specification lacks written description for the feature of "identifying the one or more users as having redeemed their coupons" (see Office Action, p. 4). Applicants respectfully disagree noting, for example, page 10 of the original specification, lines 4-6, stating "Redeemed printed coupons 6 could also have their barcodes scanned by the service to identify, for research purposes, the consumers who used the coupons."

Claims 28-29, 38 and 43: The Examiner states that the specification lacks written description for the feature of "uniquely identifying each coupon and transaction data relating to a particular coupon" (see Office Action, p. 4). Applicants respectfully disagree noting, as to unique identification, page 9 of the original specification, lines 2-5, explaining that a unique serial number could be printed on the coupon "distinguishing that coupon from all others" and that a barcode with the consumer's PIN number could be used. See also page 1, the last four lines. As to transaction data relating to a particular coupon, applicants note, for example, page 1 of the original specification, lines 19-20, explaining that transaction data "describing the particular transaction" in the case of a coupon includes "a product description, the coupon amount, and the expiration date". See also page 9, lines 11-14.

Claim 59: The Examiner States that the specification lacks

written description for the feature of "associating identification data with the redeemable coupons" (see Office Action, p. 5). Applicants respectfully disagree, noting, for example, page 10 of the original specification, lines 4-8, where it is explained that redeemed coupons could have their barcodes scanned to identify the consumers who used the coupons, or that at check-out the barcode could be compared "to ensure the consumer identity corresponds with the barcode".

Claim 60: The Examiner States that the specification lacks written description for the feature of "associating identification data with the redeemable coupons after entry of the profile data by the remote users" (see Office Action, p. 5). Applicants respectfully disagree noting, for example, FIGURE 4 and page 12 of the original specification, lines 16-20, explaining that a consumer may activate a coupon by sending the coupon file 49 to the consumer's printer where "[a]long the way, it is barcoded with the consumer's PIN 50, which is accessed from the household profile data base 64". In other words, this disclosure teaches that identification data (e.g., the barcoded PIN number) associated with a coupon is derived from the profile data, i.e., that profile data may be entered prior to the association of the identification data with a coupon. See also, e.g., original Claim 19, last paragraph.

The § 103 Rejections

Each of the pending claims 20-27, 30-35, 39-42 and 44-58 has been rejected as unpatentable over U.S. Patent No. 5,227,874 to Von Kohorn. Applicants respectfully disagree, for the reasons presented below.

The order issued by the U.S. Patent and Trademark Office granting reexamination of parent U.S. Patent No. 5,761,648 finds that Von Kohorn does not anticipate Claims 1-15 of the '648 patent because:

the service system [of Von Kohorn] does not develop correlation data which categorizes the remote user profile data. This is done by the remote unit of Von Kohorn.

(Order Granting Request For Examination, Exhibit A, page 4).

Applicants agree that the Von Kohorn "service system"

(broadcaster) does not develop correlation data. In addition, each of the other pending claims requires that "selective" or "further" offers be provided to remote users based on: an analysis of the profile data (independent Claims 20, 55, 56, 58); or "selection data"/"selection instructions" (independent Claims 49, 51); or demographic data (Claim 57). There is no such teaching in Von Kohorn. In other words, applicants have been unable to locate any teaching within the voluminous Von Kohorn patent in which promotional offers are revised and re-transmitted to consumers based on earlier-received profile or selection data provided by the consumer. Applicants note the following portions

in Von Kohorn which reference the general idea that issuers/retailers can make better informed promotional decisions if they receive consumer data, but which fail to disclose (1) the step of actually using such consumer data to revise and re-transmit "selective" offers to "selective" consumers, or (2) how a promotion is to be transmitted via broadcast in a targeted manner:

- Col. 8:44-48
- Col 2:13-17
- Col. 78:41-48
- Col. 86: 33-42
- Col. 102:11-19
- Col. 106:6-9, 23-26
- 104:41 - Co. 105:30.

Von Kohorn also fundamentally differs from the claimed invention in several other ways that implicate Applicants' currently claimed invention:

(1) Von Kohorn teaches "*broadcasting*" coupon offers to all television viewers or radio listeners within a broadcasting area (Von Kohorn, col. 6, last two full paragraphs; col.19; col. 23, lines 3-6; col. 44, lines 49-54; col. 66, lines 12-16; col. 77, lines 21-24), as opposed to the *targeted*, transmission of coupon offers to *selective* consumers based upon consumer profile information, as claimed. The Examiner notes correctly at page 6

of the Office Action that Von Kohorn employs a "central station" to "transmit broadcast product information." Because a broadcast is inherently incapable of targeted transmissions, the claimed invention is vastly different from Von Kohorn.

(2) Von Kohorn fails to disclose any requirement that consumers provide their profile data to the service system as a pre-condition to providing those consumers with coupon offers, as also claimed (see independent Claims 20, 44, 49, 55, 56 and 58, and dependent Claim 53). Instead, with Von Kohorn, consumers are exposed to a stimulus and asked to respond, such as by selecting an advertised product using the consumer's "programmed response unit," which scores the response and prints a corresponding coupon.

(3) Von Kohorn fails to reflect a rapidly interactive scheme using the Internet, e-mail or other interactive tools, as claimed. Instead, Von Kohorn discloses that game or scoring criteria, but not the coupons themselves, may be modified (Von Kohorn, col. 6, lines 13-16; col. 30, lines 57-63; col. 78, lines 22-25; col. 83, lines 54-57).

Applicants agree that the prior art of record does not provide an appropriate basis for rejection of claim 28-29, 36-38, 43 and 59-60 for which no §§ 102 or 103 rejection was made.

However, applicants request that the Examiner withdraw the § 103 rejection of the other pending claims, as well, in view of the foregoing remarks.

Reconsideration of the application and an early allowance is requested.



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Attorneys for Applicants

Dated: January 21, 2003



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

CONTROL NUMBER	FILING DATE	PATENT UNDER REEXAMINATION	ATTORNEY DOCKET NO.
90/005,641	02/18/00	5761648	47186-00004

LM41/0502
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Niro Scavone Haller and Niro
181 West Madison Street Suite 4600
Chicago IL 60602-4515

EXAMINER	
POINVIL, F	
ART UNIT	PAPER NUMBER
2768	5

DATE MAILED: 05/02/00

ORDER GRANTING/DENYING REQUEST FOR REEXAMINATION

The request for reexamination has been considered. Identification of the claims, the references relied on, and the rationale supporting the determination are attached.

Attachment(s): ☒ PTO-892, ☒ PTO-1449, ☐ Other: _____

1. ☒ The request for reexamination is GRANTED.

RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:

For Patent Owner's Statement (optional): TWO MONTHS from the mailing date hereof. 37 CFR 1.530(b).
EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

For Requester's reply (optional): TWO MONTHS from the date of service of any patent owner's statement.
37 CFR 1.535. **NO EXTENSION OF TIME IS PERMITTED.** If patent owner does not file a timely statement under 37 C.F.R. 1.530(b), no reply by requester is permitted.

2. ☐ The request for reexamination is DENIED.

This decision is not appealable. 35 U.S.C. 303(c). Requester may seek review by petition to the Commissioner within ONE MONTH from the mailing date hereof. 37 CFR 1.515(c). **EXTENSIONS OF TIME ONLY UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26(c) will be made to requester (listed below if not patent owner)
☐ by Treasury check, ☐ by credit to Deposit Account No. _____
unless notified otherwise. 35 U.S.C. 303(c).

(Third party requester's correspondence address)

Exhibit A

Art Unit: 2768

DETAILED ACTION

1. A substantial new question of patentability affecting claims 1-15 of United States Patent Number 5,761,648 to Golden et al. is raised by the request for reexamination.

Extensions of time under 37 C.F.R. § 1.136(a) will not be permitted in these proceedings because the provisions of 37 C.F.R. § 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, Office policy requires that reexamination proceedings "will be conducted with special dispatch" (37 C.F.R. § 1.550(a)) and provides for extensions of time in reexamination proceedings as set forth in 37 C.F.R. § 1.550(c).

2. The requester considers the following new questions of patentability to be raised:

(a) Claims 1-15 are anticipated under 35 USC 102(b) or would have been obvious under 35 USC 103 over Von Kohorn (US Patent No. 5,227,874).

(b) Claims 1-15 would have been obvious under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn (US Patent No. 5,227,874) in view of Von Kohorn (US Patent No. 5,128,752).

(c) Claims 1-15 would have been obvious under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn (US Patent No. 5,227,874) in view of Lemon et al. (US Patent No. 4,674,041).

Art Unit: 2768

3. It is agreed that the consideration of all the documents above in the combination enumerated raises a substantial new question of patentability as to claims 1-15 of the Golden et al. patent.

Von Kohorn ('874) patent is directed to a system and method in which a central station transmits broadcast program signals and instructional signals or command signals for operation of a response unit at a customer site. The instructional signals provide appropriate commands to the response unit for evaluating, rejecting, accepting or scoring audience responses to questions raised in the televised program. Prized coupons are provided for selection by a particular consumer. The prizes include identification data and redemption data. Note column 81, line 1 to column 84, line 54 and column 77, line 62 to column 78, line 16.

Von Kohorn ('752) discloses transmitting product information on a television or TV screen from a central station. A viewer uses a data entering unit to enter product information, verification data and product selection which the user intends to purchase in the future. Note column 5 of Von Kohorn ('752). The data unit is also used to print and generate coupon data having users' identification preprinted in the coupons. Note column 7 of Von Kohorn ('752).

Lemon et al. ('041) is directed to the distribution of coupons or certificates having transaction data and identification data imprinted therein.

Art Unit: 2768

A reasonable Examiner would have considered these documents important to the examination of the claims as pointed out in the request. As a result the request is granted.

4. The Examiner disagrees that the Von Kohorn ('874) anticipates claims 1-15 under 35 USC 102(b) because the service system does not develop correlation data which categorizes the remote user profile data. This is done by the remote unit of Von Kohorn.

5. The patent owner is reminded of their continuing responsibility to apprise the Patent and Trademark Office of any litigation activity, involving U.S. Patent ~~5,870,721~~ ^{5,761,648} during the course of these Reexamination Proceedings. See 37 CFR 1.565(a), and MPEP 2207 and 2286.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Friday from 7:30 AM - 5:00 PM.

Facsimile transmissions to this Group may be directed to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

May 1, 2000

F Poinvil
AU 2768

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FRANTZY POINVIL
PRIMARY EXAMINER
A 42768

APPROVED:
JOSEPH J. ROLLA
DIRECTOR, GROUP 2700



Notice of References Cited

Application No.
90/005,641

Applicant(s)
Golden et al.

Examiner
Frantzy Poinvil

Group Art Unit
2768

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U.S. PATENT DOCUMENTS

	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
A	4,674,041	6/16/87	Lemon et al.	705	14
B					
C					
D					
E					
F					
G					
H					
I					
J					
K					
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GROUP 3600

FOREIGN PATENT DOCUMENTS

	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
N						
O						
P						
Q						
R						
S						
T						

NON-PATENT DOCUMENTS

	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
U		
V		
W		
X		



Form PTO-1449

Atty. Docket No.

47126-0004

Patent No.

5,761,648

List of Patents and Publications for Applicant's
INFORMATION DISCLOSURE STATEMENT

Applicant

Golden et al.

Issued Date:

June 2, 1998

Group: ~~N/A~~

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Page 1 of 1

U.S. Patent Documents

Exam. Init.	Ref. Des.	Document Number	Date	Name	Class	Sub Class	Filing Date if App ^d
PD	A01	5,227,874	7/13/93	Von Kohorn	358	84	
PD	A02	5,128,752	7/7/92	Von Kohorn	358	84	
	A03						
	A04						
	A05						
	A06						
	A07						
	A08						
	A09						
	A10						

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GROUP 3600

Foreign Patent Documents

Exam. Init.	Ref. Des.	Document Number	Date	Country	Class	Sub Class	Translation Yes/No
	B01						
	B02						
	B03						

Other Art (Including Author, Title, Date Pertinent Pages, Etc.)

Exam. Init.	Ref. Des.	Citation
	C01	
	C02	
	C03	

EXAMINER: F. P. INU 1

DATE CONSIDERED: 4/13/2000

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